

REMARKS

CLAIM STATUS

Claims 1-17, 33, and 34 are now pending. Non-elected claims 18-32 have been canceled without prejudice or disclaimer. Independent claim 1 and dependent claims 2, 3, 8, and 9 have been amended and claims 33-34 have been added to improve clarity.

AMENDMENT TO SPECIFICATION

The paragraph starting at line 8 on page 22 of the specification has also been amended to improve clarity.

SUMMARY OF THE OFFICE ACTION

The outstanding Action is a non-final Action that acknowledges the election by telephone of Group I claims 1-17, acknowledges the claim for foreign priority, acknowledges the receipt of the priority documents, and acknowledges consideration of the reference filed with the Information Disclosure Statements of November 23, 2005, August 7, 2008, and March 17, 2009. The outstanding Office Action also includes an attached copy of an Interview Summary that notes the election by telephone of Group I claims 1-17 as being without traverse.

In addition to the above-noted acknowledgements and Interview Summary, the outstanding Action presents an objection to claims 1 and 2, a repetition of the telephone Restriction Requirement requesting affirmation of the election of Group I claims 1-17 without traverse, an express rejection of claims 1-4 under 35 U.S.C. §102(e) as being anticipated by Sapuram et al. (U.S. Patent Application Publication No. 2004/0015596, hereinafter "Sapuram"), an apparent improperly presented implied rejection of claims 7, 8, and 13-15 based on Sapuram, an express rejection of claim 5 under 35 U.S.C. §103(a) as being unpatentable over Sapuram in view of Braithwaite et al. (U.S. Patent Application Publication No. 2004/0193893, hereinafter "Braithwaite"), an express rejection of claim 6 under 35 U.S.C. §103(a) unpatentable over Sapuram in view of Braithwaite in further view of Chang et al. (U.S. Patent Application Publication No. 2002/0062397, hereinafter "Chang"), an express rejection of claim 9 under 35

U.S.C. §103(a) unpatentable over Sapuram in view of Ney et al. (U.S. Patent No. 4,653,838, hereinafter "Ney"), an express rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over Sapuram in view of Jarvensivu (U.S. Patent Application Publication No. 2002/0188736), an express rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Sapuram in view of Jarvensivu in further view of Tanaka (U.S. Patent No. 5,845,069), and an express rejection of claims 16 and 17 under 35 U.S.C. §103(a) unpatentable over Sapuram in view of Thompson (U.S. Patent No. 5,465,401).

SUBSTANCE OF TELEPHONE INTERVIEW

Applicant affirms the telephone election of Group I claims 1-17 as being without traverse as set forth in the Interview Summary attached to the outstanding Action. This was the only matter discussed in the telephone conversation between Applicants' representative and Examiner Scott.

OBJECTIONS TO CLAIMS 1 AND 2

Item 2 on page 2 of the outstanding Action presents the above-noted objections to claims 1 and 2.

The amendment made to claim 1 removes the objected to language such that it is believed that this objection should be withdrawn as having been overcome.

The above-noted objection to claim 2 is not understood as claim 2 does not contain the language noted to be objectionable. Accordingly, the objection made as to claim 2 should also be withdrawn.

EXPRESS REJECTION OF CLAIMS 1-4 UNDER 35 U.S.C. §102

Item 3 on page 4 of the outstanding Action presents the above-noted rejection of claims 1-4 under 35 U.S.C. §102(e) as being allegedly anticipated by Sapuram. This rejection is traversed

Turning to amended independent claim 1 it is noted that this claim now requires, *inter alia*, "an application managing unit that analyzes application data to determine a connector that specifies information indicating a function required for executing said application." There is no

teaching or suggestion in Sapuram of any analysis of application data to determine anything, much less the amended independent claim 1 required determination of “a connector that specifies information indicating a function required for executing said application.” As noted in paragraph [0037] of Sapuram (at lines 12-13 of this paragraph), it is the route 1101 that “defines a list of connectors to be traversed from a source to a destination,” not any “analysis” of any “application data” as required by amended independent claim 1.

Further, there is no teaching or suggestion to be found in Sapuram of the further requirement of amended independent claim 1 for “a connector obtaining unit responsive to the application management unit determination of the connector so as to obtain the connector.” Also missing from Sapuram is any teaching or suggestion of the amended independent claim 1 recited “function utilizing unit accessing a location of said function based on access information relating to the location described in information contained by said connector, and utilizing said function specified by said connector.”

Therefore, as Sapuram clearly does not disclose each and every element of amended independent claim 1, much less and every element of amended independent claim 1 arranged together exactly as in the claimed arrangement, withdrawal of the improper rejection of independent claim 1 as being allegedly anticipated by Sapuram is respectfully requested.

Furthermore, as claims 2-4 depend either directly or indirectly from amended independent claim 1, these dependent claims are respectfully submitted to be improperly rejected as being anticipated by Sapuram for at least the same reason as noted above as to parent independent claim 1. Accordingly, the withdrawal of the improper rejection of dependent claims 2-4 as being allegedly anticipated by Sapuram is also respectfully requested.

IMPROPER IMPLIED REJECTION OF CLAIMS 7, 8, AND 13-15

Pages 5-7 of the outstanding Action present the above-noted improper implied rejection of claims 7, 8, and 13-15 based on Sapuram. In this regard, none of the paragraphs on pages 5-7 of the outstanding Action uses the word “reject” in any form in association with claims 7, 8, and 13-15. These paragraphs also fail to set forth any statutory basis for the apparent refusal to allow claims 7, 8, and 13-15. Thus, the outstanding Action clearly violates MPEP §707.07(d) that

states that when “a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated, and the word ‘reject’ must be used” (emphasis added). This MPEP section further notes that the examiner is to “designate the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection” (emphasis added).

Accordingly, the improper refusal to allow claims 7, 8, and 13-15 will be treated no further except to note that the paragraphs on pages 5-7 of the outstanding Action that appear to be attempted improper implied rejections of claims 7, 8, and 13-15 must be withdrawn based upon the failure to comply with the above-noted dictates of MPEP §707.07(d).

These paragraphs on pages 5-7 of the outstanding Action that appear to be attempted improper implied rejections of claims 7, 8, and 13-15 should further be withdrawn as failing to comply with 35 U.S.C. § 132 that requires that the applicants must be notified of the reasons for any claim rejection. Such reasons for rejecting any of claims 7, 8, and 13-15 clearly require a statement as to the statutory basis for any such rejection. In this regard, it is well established that responding to a rejection under 35 U.S.C. § 103 may well include arguments and evidence (e.g., related to secondary considerations) that have no bearing on a response to a rejection under 35 U.S.C. § 102.

EXPRESS REJECTION OF CLAIMS 5, 6, 9-12, 16, AND 17 UNDER 35 U.S.C. §103(a)

The above-noted express 35 U.S.C. §103(a) rejections of dependent claims 5 (as being unpatentable over Sapuram in view of Braithwaite), 6 (as being unpatentable over Sapuram in view of Braithwaite in further view of Chang), 9 (as being unpatentable over Sapuram in view of Ney), 10 (as being unpatentable over Sapuram in view of Jarvensivu), 11 and 12 (as being unpatentable over Sapuram in view of Jarvensivu in further view of Tanaka, and 16 and 17 (as being unpatentable over Sapuram in view of Thompson) are all traversed.

Braithwaite is added to Sapuram as to the subject matter added by dependent claim 5, Braithwaite in further view of Chang are added to Sapuram as to the subject matter added by dependent claim 6, Ney is added to Sapuram as to the subject matter added by dependent claim 9, Jarvensivu is added to Sapuram as to the subject matter added by dependent claim 10,

Jarvensivu in further view of Tanaka are added to Sapuram as to the subject matter added by dependent claims 11 and 12, and Thompson is added to Sapuram as to the subject matter added by dependent claims 16 and 17. However none of Braithwaite, Chang, Ney, Jarvensivu, Tanaka, and/or Thompson considered alone or together in any proper combination cure the deficiencies noted above as to the reliance on Sapuram. Accordingly, dependent claims 5, 6, 9-12, 16, and 17 patentably define over the applied references for at least the same reason that parent independent claim 1 patentably defines over Sapuram and the withdrawal of these rejections of dependent claims 5, 6, 9-12, 16, and 17 under 35 U.S.C. §103(a) is respectfully requested.

In addition, it is clear that the outstanding Action has improperly relied on each of the secondary references (Braithwaite, Chang, Ney, Jarvensivu, Tanaka, and Thompson) by extracting only partial teachings from each of these references. These extracted partial teachings have been taken completely out of context and then expanded to create abstract teachings of far greater scope than any actual teaching of any of these references properly considered in actual context.

For example, paragraph [0050] of Braithwaite (either at relied on lines 7-11 or at relied on lines 8-13) clearly does not teach “the general concepts wherein said function utilizing unit converts a result obtained from said function based on said data conversion information.” Instead of teaching any general concepts at all, paragraph [0050] of Braithwaite teaches the specifics of transferring an existing user biometric template created for enrollment with one application from the enrollment database for that application to another enrollment database for a different application and in a different format as follows:

As shown in FIG. 3, at step 304 user 1 requests and authorizes the transfer of user 1's existing enrollment template, created for application A, to the enrollment database for application B. At step 408 a Template Authority submits a (preferably) authenticated request to application A database, DB_A for user 1's enrolled template, that exists in the database DB_A in a format consistent with application A. Upon receiving user 1's template, at step 312 the Template Authority retrieves application A's transformation function F_A (e.g. from archival storage), inverts it, and then converts the result at step 316 to Application B's format by applying the Application B format F_B . According to this aspect of the invention, an application transformation is not exposed to another application, and yet users may be able to use their existing enrollments for new applications

without incurring the cost and inconvenience of re-enrolling their biometric for each new application.

While the “Template Authority” may retrieve a transformation function from one database, invert this retrieved transformation function and then convert the inverted result to the required format for the second database, this inversion-conversion of a transformation function is not a teaching of a general concept of converting “a result obtained from said function based on said data conversion information” as incorrectly stated. In this last regard, *In re Kotzab* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) notes that “[reference] statements cannot be viewed in the abstract” because “they must be considered in the context of the teaching of the entire reference.” Further note *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) establishing that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”

In addition to improperly extracting partial reference teachings and then improperly expanding such extracted partial teachings into abstract principles, it is noted that the outstanding Action has clearly misinterpreted the Ney teachings of storage of an electrical circuit board hardware “connector” as somehow applicable to the Sapuram “connector” that “is a general term for applications that communicate with other applications,” as explained in lines 1 and 2 of paragraph [0027] of Sapuram. Clearly, teachings as to the Ney circuit board “connectors” are not relevant to either the Sapuram taught “connector” or the “connector” of this application.

Moreover, MPEP §706.02(j) requires that in order to support a rejection under 35 U.S.C. 103(a), the examiner is to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter.” As explained here, such an explanation is necessary because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” This is more than mere guidance by the MPEP as above-noted 35 U.S.C. § 132 requires that the applicant be notified of the “reasons” for the rejection of the claim so that he or she can decide how best to proceed. Contrary to these requirements, the outstanding Action fails

to explain the modification that is being proposed to be made to Sapuram based upon the improperly extracted partial teachings of these above-noted secondary references. Instead, the outstanding Action repeatedly states (see page 8, lines 4-8, for example) that it “would have been obvious ... to combine Sapuram et al with the general concept” However, the general concepts being referenced are not the actual reference teachings. Instead, and as explained above, these concepts relate to improperly extracted incomplete reference teachings that the outstanding Action has improperly and completely subjectively expanded into abstract principles without production of even a shred of evidence to support this expansion.

Thus, not only do these express 35 U.S.C. §103(a) rejections of dependent claims 5 (as being unpatentable over Sapuram in view of Braithwaite), 6 (as being unpatentable over Sapuram in view of Braithwaite in further view of Chang), 9 (as being unpatentable over Sapuram in view of Ney), 10 (as being unpatentable over Sapuram in view of Jarvensivu), 11 and 12 (as being unpatentable over Sapuram in view of Jarvensivu in further view of Tanaka, and 16 and 17 (being unpatentable over Sapuram in view of Thompson) fail to establish a valid *prima facie* case of obviousness as to the subject matter of base independent amended claim 1, they also fail because they are clearly hindsight reconstructions that improperly rely on extracting isolated incomplete reference teachings that are then improperly subjectively expanded into abstract principles to address the claim language requirements with total disregard as to the entirety of the actual reference teaching. These obviousness rejections also fail because none of them make any identification of “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” as noted above. Accordingly, withdrawal of these rejections of dependent claims 5, 6, 9-12, 16, and 17 under 35 U.S.C. §103(a) is respectfully requested for these reasons as well.

NEW CLAIMS 33 and 34

New claim 33 is an independent claim that closely parallels amended independent claim 1 while presenting added details as to the amended independent claim 1 recited “function utilizing unit.” In this respect, new independent claim 33 recites both “an external function management unit” and “an internal function management unit.” Just as none of the applied

references (Sapuram, Braithwaite, Chang, Ney, Jarvensivu, Tanaka, and/or Thompson) taken alone or in any proper combination can be reasonably said to teach or suggest the subject matter of amended independent claim 1, neither can they (taken alone or in any proper combination) be said to teach or suggest the subject matter of new independent claim 33 that parallels amended independent claim 1.

In addition, new dependent claim 34 closely parallels dependent claim 9 and thus should be considered to patentably define over all the applied references considered alone or together in any proper combination for at least the same reasons set forth above as to dependent claim 9.

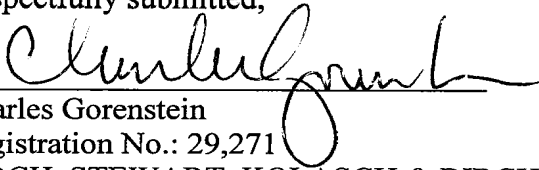
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: July 14, 2009

Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant